

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUSHIGE NAKAMURA,
SHINICHI YAOI, TOMOAKI TANAKA and
OSHIMICHI KATAGIRI

Appeal 2007-0889
Application 09/935,668
Technology Center 1700

Decided: April 20 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and JEFFREY T.
SMITH, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3-5, 7, 9-11, 13, 14, and 18-22. Claims 1 and 19 are illustrative:

1. An imaging color toner comprising at least a binder resin, a colorant and an infrared absorber, wherein

the binder resin contains, as a principal component, a polyester resin obtained by mixing a first polyester resin with a second polyester resin in a weight ratio of 80:20 to 20:80;

the first polyester resin is a crosslinked polyester resin having a softening point Tsp of not lower than 120°C and lower than 170°C, and also contains 1 to 25 parts by weight of a chloroform-insoluble content as the component; and

the second polyester resin is a non-crosslinked polyester resin having a softening point Tsp of not lower than 80°C and lower than 110°C, wherein the toner is capable of being photofixed; and

wherein an acid value of the first polyester resin is from 20 to 40, an acid value of the second polyester resin is from 5 to 20, and an acid value of the entire polyester resin is from 15 to 35.

19. An imaging color toner comprising at least a binder resin, a colorant and an infrared absorber, wherein;

the binder resin contains, as a principal component, a polyester resin obtained by mixing a first polyester resin with a second polyester resin in a weight ratio of 80:20 to 20:80;

the first polyester resin is a crosslinked polyester resin having a softening point Tsp of not lower than 120°C and lower than 170°C, and also contains 1 to 25 parts by weight of a chloroform-insoluble content as the component; and

the second polyester resin is a non-crosslinked polyester resin having a softening point Tsp of 110°C, wherein the toner is capable of being photofixed; and

wherein an acid value of the first polyester resin is from 20 to 40, an acid value of the second polyester resin is from 5 to 20, and an acid value of the entire polyester resin is from 15 to 35.

Appellants' claimed invention is directed to an imaging color toner comprising a binder resin that is a mixture of first and second polyester resins. The first polyester resin is a crosslinked polyester and the second polyester resin is a non-crosslinked, linear polyester resin having a softening point (Tsp) of not lower than 80°C and lower than 110°C. According to Appellants' Specification, if the second polyester resin has a Tsp equal to or greater than 110°C, low energy fixability is lowered.

Appealed claims 1, 3-5, 7, 9-11, 13, 14, and 18-22 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

We have thoroughly reviewed the respective positions advanced by Appellants and the Examiner. In so doing, we concur with Appellants that the subject matter of claims 1, 3-5, 7-11, 13, 14, 18, 20, and 21 finds descriptive support in the original Specification. However, we agree with the Examiner that the subject matter of claims 19 and 22 is not originally described in the Specification. Accordingly, we will sustain the Examiner's § 112, first paragraph, rejection of claims 19 and 22, but reverse the Examiner's rejection of claims 1, 3-5, 7-11, 13, 14, 18, 20, and 21.

The essence of the Examiner's § 112, first paragraph, rejection is that Appellants' original Specification describes only a second *non-linear* polyester resin having a Tsp of not lower than 80°C and lower than 110°C. Therefore, the Examiner reasons that there is no original descriptive support of the presently claimed second polyester resin that is a non-crosslinked resin or linear resin. While the Examiner acknowledges that Appellants' exemplified second polyester resins, Polyester 2-2 and Polyester 2-3, are

non-crosslinked, linear resins, it is the Examiner's position that these two second polyester resins are not sufficient to provide original descriptive support for the breadth of second polyester resins claimed.

Appellants, on the other hand, maintain that one of ordinary skill in the art would have recognized the error in the original Specification which describes the second polyester resin as non-linear. Appellants contend that one of ordinary skill in the art, upon reading the Specification and descriptions in the examples, "would have recognized the existence of the error in the specification, i.e., that the description of the non-crosslinked polymer as 'non-linear' was an error, and would have realized that the correction would have been that the second polymer should have been referred to as 'non-crosslinked' (claims 1 and 19) or 'linear' (claims 20 and 22)" (page 13 of principal Br., first paragraph). Appellants also rely upon a Declaration of Dr. Masatoshi Kimura as evidence that an expert in polymer chemistry would have "easily recognized that an error was apparent, and also easily recognized what the correct meaning should have been" (page 14 of principal Br., second para.).

In reaching our decision, we find that the Kimura Declaration is of limited probative value. While Appellants present Dr. Kimura as "an expert in polymer chemistry" (page 14 of principal Br., third para.), the Declaration states that Dr. Kimura graduated from the Department of Electronic Engineering in 1973, completed a masters course in the Department of Electronic Engineering in 1975, and has a doctorate in Engineering, in addition to being engaged in research and development of an electrostatic recording process and an electrophotographic process. However, the Declaration does not establish Dr. Kimura as an expert in polymer

chemistry. Also, it would appear that Dr. Kimura is employed by the assignee of the present invention, namely, Fuji Xerox Co., Ltd.

Notwithstanding our assessment of the Kimura Declaration, we find that the original Specification provides descriptive support for the second polyester resin being non-crosslinked and linear and having a Tsp of not lower than 80°C and lower than 110°C. As appreciated by the Examiner, all five exemplified second polyester resins (2-1, 2-2, 2-3, 2-4, and 2-5), whether they are second polyester resins of the present invention or second polyester resins offered for comparison, are linear, non-crosslinked resins. Also, the description in the Specification at page 11, lines 15 et. seq. only describes crosslinking the first polyester resin. Accordingly, inasmuch as the original Specification exemplifies only non-crosslinked, linear resins as the second polyester resins, we are satisfied that the original Specification would convey to one of ordinary skill in the art the concept that the second polyester resin is a linear, non-crosslinked resin, in contrast to the crosslinked, first polyester resin.

We will sustain the Examiner's § 112, first paragraph, rejection of claims 19 and 22, which define the second polyester resin as having a softening point Tsp of 110°C. We agree with the Examiner that the original Specification, as well as the amended, present Specification, clearly teaches that the second polyester resin has a softening point Tsp of not lower than 80°C and *lower than 110° C*. Appellants' Specification, in discussing the second polyester resin, expressly discloses that "[w]hen the softening point Tsp of the polyester resin is 110°C or higher, low energy fixability is lowered" (page 8, ll. 26-28). Manifestly, second, linear polyester resins having a Tsp of 110°C are outside the scope of Appellants' invention.

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Accordingly, we concur with the Examiner that the original Specification does not convey to one of ordinary skill in the art the concept that the subject matter of claims 19 and 22, which includes second polyester resins having a Tsp of 110°C, is part of the present invention.

In conclusion, based on the foregoing, the Examiner's § 112 rejection of claims 19 and 22 is sustained, but the Examiner's § 112 rejection of claims 1, 3-5, 7-11, 13, 14, 18, 20, and 21 is reversed. The Examiner's decision rejecting the appealed claims is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv)(effective Sept. 13, 2004).

AFFIRMED-IN-PART

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